

REMARKS

Applicants submit these remarks in response to the Office Action dated December 24, 2003 ("Office Action"). The three-month deadline for filing a response falls on March 24, 2004, and therefore Applicants believe that this response is timely filed, and that no fees are due in connection with this submission. In the event that Applicants are incorrect in their assumption, please charge any fee due in connection with this submission to Deposit Account No. 50-2212, Order Number 044988.030.4557.

Telephonic Interview with Examiner

Applicants thank the Examiner for taking the time to discuss the outstanding rejections with the undersigned on February 10, 2004. The following amendments and comments summarize what was discussed during the telephone interview.

Rejection under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 1-3 and 25-27 as lacking enablement under 35 U.S.C. § 112, first paragraph. Specifically, the Examiner states that "the specification, while being enabling for methods which are limited to at least requiring the selection of M compounds via a fitness function, does not reasonably provide enablement for methods without any fitness functions selection requirement." Office Action at page 2. Applicants assert that the full scope of the rejected claims are supported by an enabling disclosure and therefore the rejection is improper.

"The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which postured the question: is the experimentation needed to practice the invention undue or unreasonable?" M.P.E.P. § 2164.01. In other words, "the test for enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent

coupled with information known in the art without undue experimentation.” *United States v. Telectronics, Inc.*, 857 F.2d 778, 785 (Fed. Cir. 1988). Applicants assert that based on the description of the invention provided in the specification and the level of skill in the art, the rejected claims are sufficiently enabled to meet this standard of “no undue experimentation.”

Nevertheless, in order to expedite prosecution of the pending application, Applicants have, as suggested by the Examiner, amended claims 1 and 25 to recite that the selection of M compounds from N enumerated compounds is “based on at least one fitness function.”

Applicants believe that these arguments and amendments overcome the Examiners rejection and that claims 1-3 and 25-27 are in condition for allowance.

Rejection under 35 U.S.C. § 112, second paragraph

The Examiner has also rejected claim 24 under 35 U.S.C. § 112, second paragraph. Applicants thank the Examiner for pointing out the typographical error made in the listing of claims filed with Applicant’s Amendment and Response to Office Action filed October 27, 2003. To correct this error, Applicants have amended claim 24 to add the phrase “a fitness function” after the phrase “a first function that enables the processor to select M compounds of said set of N enumerated compounds based on.” This amendment also corrects antecedent basis of the phrase “the fitness function” as used in the last line of claim 24.

Applicants believe that correction of this typographical error places claim 24 in condition for allowance.

Rejection under 35 U.S.C. § 101

The Examiner has rejected claims 1-3, 7-27, and 31-48 under 35 U.S.C. § 101 as allegedly directed to non-statutory matter. Office Action at page 4. Applicants respectfully assert that this rejection is improper.

To properly make a rejection under 35 U.S.C. § 101 the Examiner must establish that “the claimed invention as a whole is directed to solely an abstract idea or to manipulation of abstract ideas or does not produce a useful result. Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under 35 U.S.C. § 101.”

M.P.E.P. § 2106(II)(A). “To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or (B) be limited to a practical application within the technological arts.” M.P.E.P. § 2106(IV)(B)(2)(b) (emphasis added). The Examiner, by asserting that the claim must have a step wherein there is “some physical transformation outside of a computer,” appears to have focused on alternative (A). However, Applicants contend that the present invention is more appropriately classified under alternative (B) and therefore does not require recitation of a physical transformation outside of the computer.

The following example found at M.P.E.P. § 2106(IV)(B)(2)(b)(ii) supports Applicants position:

A computer process that simply calculates a mathematical algorithm that models noise is nonstatutory. However, a claimed process for digitally filtering noise employing the mathematical algorithm is statutory.

Applicants claimed invention is analogous to the second example and is therefore directed to statutory subject matter. Specifically, the presently claimed invention encompasses a method for generating a focused library of compounds from a non-enumerated virtual library of compounds. True that to carry out this transformation, Applicants claimed invention employs a mathematical algorithm. However, this is alone is not determinative. Rather, the Examiner must determine whether the claimed invention “merely manipulates an abstract idea” or “is limited to a practical application of the abstract idea or mathematical application in the technological arts.” M.P.E.P. § 2106(IV)(B)(2)(b)(ii). As can be found throughout Applicants specification, the presently claimed method has at least one practical application within the technological arts, therefore Applicants assert that the claims are proper under 35 U.S.C. § 101 without reciting a particular physical transformation outside of the computer.

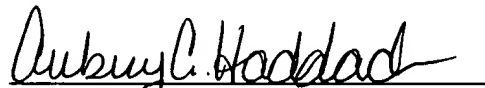
Applicants believe that these arguments overcome the Examiner’s rejection under 35 U.S.C. § 101 and that claims 1-3, 7-27, and 31-48 are in condition for allowance.

CONCLUSION

In view of the foregoing, Applicants assert that the rejection of Claims 1-3, 7-27, and 31-48 have been overcome and therefore the pending claims are in condition for allowance. Accordingly, Applicants request prompt and favorable action.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,



Aubrey A. Haddach
Registration No. 48,374
PILLSBURY WINTHROP, LLP
11682 El Camino Real, Suite 200
San Diego, California 92130-2092
(858) 847-4189

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